



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,017	02/14/2001	Hiroshi Kamiya	Q63036	3808

7590 03/29/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,017

Applicant(s)

KAMIYA, HIROSHI

Examiner

Marissa Thein

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.5
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements (IDS) submitted on February 14, 2001 and September 3, 2002 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Drawings

The drawing filed on February 14, 2001 are acceptable.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

Art Unit: 3625

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-3 only recites an abstract idea. The recited steps of an order issuer side requesting an electronic document having input fields for order issuer information and for commodity order issuance information and the transmitting of the documents does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to request and transmits electronic documents between an order issuer side and an order acceptor side.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a commodity order transaction by requesting and transmitting electronic documents between the order issuer side and the order acceptor side (i.e., useful and tangible).

Art Unit: 3625

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-3 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,630,071 to Sakai et al.

Regarding claims 1, 4, and 7, Sakai discloses a commodity order issuing and accepting method, system and apparatus comprising:

- the requesting a first electronic document having first input fields for order issuer information and for commodity order issuance information except for an order issuer's payment date from an order issuer side to an order acceptor side (see at least col. 2, lines 50-col. 3, line 5; col. 3, line 41-col. 4, line 7; Figure 13; col. 8, line 66 – col. 9, line 13; Figure 20);
- the transmitting the first electronic document from the order acceptor side to the order issuer side (see at least col. 2, lines 50-col. 3, line 5; ; col. 3, line 41-col. 4, line 12; col. 9, lines 14-29; Figure 14; Figure 20);
- the inputting/receiving the order issuer information and the commodity order issuance information except for the order issuer's payment date to the first input

Art Unit: 3625

fields on the order issuer side (see at least col. 2, lines 50-col. 3, line 5; ; col. 3, line 41-col. 4, line 12; col. 9, lines 14-29; Figure 14; Figure 20);

- the transmitting the order issuer information and the commodity order issuance information except for the order issuers' payment date from the order issuer side to the order acceptor side (see at least col. 2, lines 50-col. 3, line 5; ; col. 3, line 41-col. 4, line 12; col. 9, lines 30-35; Figure 14; Figures 20-21);
- the retrieving a transaction condition corresponding to the commodity order issuance information except for the order issuer's payment date on the order acceptor side (see at least col. 3, lines 12-40; Figure 20-21)
- the transmitting a second electronic document on which the transaction condition is described and which has a second input field for the order issuer's payment date from the order acceptor side to the order issuer side (see at least col. 3, lines 3-40; col. 4, lines 23-52; Figure 20-21)
- the inputting/receiving the order issuers' payment date to the second input field on the order issuer side (see at least col. 4, lines 23-52; Figures 21-22) and
- the transmitting the order issuers' payment date from the order issuer side to the order acceptor side (see at least col. 4, lines 23-52; Figure 18; Figures 21-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 5-6, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,630,071 to Sakai et al. in view of U.S. Patent No. 6,168,076 to Yamamoto et al. Sakai substantially discloses the claimed invention, specifically, the authentication (see at least col. 3, lines 8-40, col. 7, line 58 – col. 8, line 16). However, Sakai does not disclose the calculation of a reduced price. Sakai disclose a total amount calculation section for calculating a total value of prices of commodities retrieved by the commodity price retrieval section and the total value of the prices of the commodities calculated by the total amount calculation section (see at least col. 3, lines 14-21). Yamamoto, on the other hand, teaches the calculation of a reduced price (col. 1, lines 46-50). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system and apparatus of Sakai, to include the calculation of the reduced price, in order to provide a discount price to the customer, thus enabling to calculate the total sum of the order (col. 5, lines 61-62).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,914,878 to Yamamoto et al. discloses a raw material ordering system.

U.S. Patent No. 5,481,094 to Suda discloses a point of sale terminal for making a package discount with respect to commodities previously purchased.

Art Unit: 3625

U.S. Patent No. 6,477,507 to Sugimori discloses an online commodity management system.

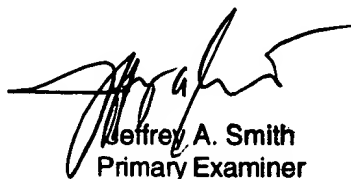
U.S. Patent No. 6,669,832 to Saito et al. disclose an electronic transaction system that electronically makes requests to supplier or vendors for estimates and orders for commodities.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
March 19, 2004



Jeffrey A. Smith
Primary Examiner